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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,174	08/27/2001	Lane W. Lee	M-12038 US	5308

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MACPHERSON KWOK CHEN & HEID LLP  
1762 TECHNOLOGY DRIVE  
SUITE 226  
SAN JOSE, CA 95110

EXAMINER

HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/940,174

Applicant(s)

LEE ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 9, 15, 17, 18, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9, 15, 17, 18, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

1. Claims 1-3, 9, 15, 17, 18, 21 and 22.

***Response to Arguments***

2. Applicant attempts to differentiate the claimed method and apparatus from the prior art based on conditional or optional language (e.g. "if", "whether"). However, language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP, 2106, II, C).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 15, 17, 18 and 22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Morito, U.S. Patent No. 6,782,190.

As per claims 1, 2, 15, 17, 18, 21 and 22, Morito teaches a method and system for detecting unauthorized actions with respect to content on an optical disk comprising:

- reading an identifier on an optical disk (column 4, lines 20-65; column/line 5/63-6/3)
- determining whether the identifier was located in the read-only (i.e. Sp) or writeable portion (i.e. Sd) of the media disk (column/line 5/63-6/3)
- determining whether the identifier is pre-recorded (column 6, lines 8-11) or written (column 5, lines 60-64; column 6, lines 3-7) and if the identifier is pre-recorded (figures 1 and 2) and in the writeable portion (i.e. comparison step) then detecting an unauthorized action (i.e. detecting that the identifier from the ROM area Sp is different from the identifier Sd in the copy control information of the writeable area) using only the identifier in the writeable portion (column/line 5/64-6/5; column 6, lines 12-15)
- reading the identifier during an optical disk [access] operation including one or more of record, play, get play key, copy, open, close or create (abstract; column/line 7/64-8/21)

As per claim 21, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. Hence, as Morito clearly discloses a structure comprising Applicant's reading means (column 4, lines 20-65; column/line 5/63-6/3), determining means (column/line 5/60-6/11) and detecting means (column 6, lines 12-15), Applicant's claim 21 is anticipated by the prior art.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morito, U.S. Patent No. 6,782,190 in view of Ram et al., U.S. Patent No. 6,519,700.

As per claim 3, Morito discloses content copy protection (abstract). Specifically, Morito teaches detecting unauthorized copying of content from one optical disk to another. However, Morito does not explicitly recite revoking rights

to content. Ram et al. teach revoking a user's access to content after detecting unauthorized use (column 8, lines 20-23). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Morito and Ram et al. in order to extend the copy protection scheme of Morito. For example, by implementing the Morito system with additional rights directed to the content itself ('700, column 8, lines 1-22), content "ripped" from the optical disk cannot be redistributed without authorization from the content owner.

7. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morito, U.S. Patent No. 6,782,190.

As per claims 9 and 21, Morito teaches reading an identifier on a media disk (column 4, lines 20-65; column/line 5/63-6/3). Claims 9 and 21 are dedicated to a description of the identifier. However, this is non-functional data as the method and apparatus do not perform key generation and using a generated key to decrypt files. Recall claims 1 and 15, from which claims 9 and 21 depend, respectively, are dedicated to detecting unauthorized actions. The MPEP defines non-functional descriptive material as data that does not alter the performance of a process or computer (2106 section V, B, 2). Therefore, to one of ordinary skill once said unauthorized action is identified no further processing or access is permitted (for example see claim 3) (descriptive material cannot render nonobvious an invention that would have otherwise been obvious (*In re Gulack*,

703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

### ***Conclusion***

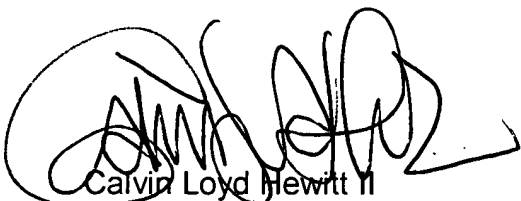
8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Calvin Loyd Hewitt II  
Primary Examiner

December 4, 2006